

REMARKS

In the Final Official Action mailed 18 December 2006, the Examiner reviewed claims 1, 3-5, 7-11 and 31-22.

The Examiner has objected to the specification because it contains embedded hyperlinks and/or other forms of browser-executable code. With this response, Applicants have amended the specification in accordance with the Examiner's requirement.

The Examiner has rejected claims 1, 7 and 14 under 35 U.S.C. §112, second paragraph; as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 3-5, 7-10 and 13-22 are rejected under 35 U.S.C. §102(e) as being anticipated by Fuller (U.S. Patent No. 6,216,112). Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Fuller (U.S. Patent No. 6,216,112).

Rejections under 35 USC § 112 of Claims 1, 7 and 14

The Examiner rejected Claims 1, 7 and 14 under Section 112, second paragraph, based on language reciting that particular items were "not inextricably tied to a particular member item."

The language in question has been excised from the claims. It is therefore respectfully suggested that the rejection under Section 112 should be withdrawn.

Rejections under 35 USC § 102(e) of Claims 1, 3-5, 7-10 and 13-22

The Examiner further rejected Claims 1, 3-5, 7-10 and 13-22 under 35 USC § 102(e) as having being anticipated by US Patent No. 6,216,112, to Fuller. With this amendment, Applicants have cancelled Claims 14-22.

The Technology

The present application discloses and claims a method and system for presenting content items to computer users. As best seen in Fig. 2, a user computer 101 employs a web browser 201 for accessing and retrieving content via the Internet. Member items 203 are downloaded to the user computer, those items including a standalone application known as a bolting engine 205 with support files 206, which may include memory and ancillary data. Cookies 204 are used to communicate between the user computer and a support server 103, seen in Fig. 1. The items 203 can include utility programs or add-ons, or content such as advertising material.

Following the process set out in flowchart form in Fig. 3, the system checks to ensure that a user computer has actually received member items previously (step 306), and then further

checks to ensure that the user computer actually retains at least one member item (step 310). If either of those questions returns a negative response, provision of further items is terminated.

Further, the content of advertising is matched to the interests of the user (page 8, line 19 – page 9, line 19). That result is accomplished by first identifying the webpage being viewed by the user, together with the webpage content, and then matching the content of advertising provided to the user. Thus, a user viewing digital camera material on the Internet can receive a timely advertisement showing sale prices of digital cameras.

The Rejection

U.S. Patent No. 6,216,112, to Fuller, discloses a “Method for Software Distribution and Compensation with Replenishable Advertisements.” Here software packages on a server are offered to users together with “adware” packages that facilitate the delivery and display of advertising to the users.

That reference forms the basis for the Examiner’s rejection under Section 102(e). The Examiner’s misapplication of the art, however, completely undermines the rejection.

First, the Examiner equates the procedures outlined in Fuller and in the present application regarding the consequences of the user deleting all of the downloaded “items.” In Fuller, as shown in Fig. 3, step 318 *et seq.* and accompanying text, the program queries the user about whether the user wants adware (step 322), and a positive response evokes still more steps. In contrast, the method of the claimed invention sets out a simple cessation of activity. Once the user has expressed her intentions, by deleting the items, the program does not bother the user any further. That streamlining is important in maintaining user confidence and goodwill, which can be lost by forcing the user to answer further questions after the user has indicated a desire to be free of advertising. Conventional approaches call for continuing to push at the user, but the present application teaches a different view, and presents a different method.

Moreover, the Examiner incorrectly equates Fuller’s teaching with that of the claimed invention in selecting advertising for the user. Fuller teaches a number of steps that could be taken in selecting advertising. The selecting system can rely on the general subject matter of the downloaded program (sports advertisement for a sports-related program, for example), or the user could enter keywords, or the system could make use of some unspecified purchasing preference database. It should be noted that Fuller does not explain how such a database should be constructed within the constraints of privacy laws or within some technical disclosure of a method for doing so.

What is important, however, is that all of these methods, based on selected advertisements far in advance of their actual display, are inherently crude. The chances that such a selection would display an advertisement linked to what a user was doing at that moment are, at best, remote. The claimed invention, in contrast, looks to the exact webpage that the user is viewing, selects an advertisement based on the content of that page.

The Examiner's stated that Fuller's provision of different advertisements with different software "reads on advertising that is selected based on a web page viewed by a user." (OA at 4). That statement fails on its face. The claim language is clear, and Fuller does something different. Fuller shoots in the dark, aiming in the general direction of a target. The Examiner would equate that process with ascertaining exactly what a user is doing at a given moment and choosing advertising to match. Those two processes are not the same.

In sum, the claims as amended define clear differences that separate the method and system from Fuller. As now set out, Fuller does not anticipate every element of the claims. Accordingly, withdrawal of the rejection under Section 102(e) is respectfully suggested.

Rejections under 35 USC §103 of Claim 12 [sic]

The Examiner rejected Claim 12 [sic] under 35 USC §103(a) as having been obvious to a person of ordinary skill in the art.

First, it is presumed from context that the Examiner referred to Claim 11, Claim 12 having been cancelled.

Then, Claim 7, from which Claim 11 depends, having been shown to be patentable, it is respectfully pointed out that Claim 11 is likewise patentable.

CONCLUSION

It is respectfully submitted that this application is now in condition for allowance.

Fee Authorization. The Commissioner is hereby authorized to charge any additional fee(s) determined to be due in connection with this communication, or credit any overpayment, to our Deposit Account No. 50-0869 (CLAR 1037-1).

Respectfully submitted,

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